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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,955	12/27/2000	Tadayoshi Iijima	P107424-00020	3185

23353 7590 12/13/2006

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WASHINGTON, DC 20036

EXAMINER
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JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/747,955

Applicant(s)

IIJIMA, TADAYOSHI

Examiner

Monique R. Jackson

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 17, 18, 21, 22, 24-26, 28-30, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 17, 18, 21, 22, 24-26, 28-30, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The amendment filed 10/2/06 has been entered. Claim 16 has been canceled. Claims 1-3, 17-18, 21-22, 24-26, 28-30, 33 and 34 are pending in the application. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Double Patenting*

2. Claims 1-3, 17-18, 21, 22, 24-26, 28-30, 33 and 34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 and 13-18 of U.S. Patent No. 6,605,341, as evidenced by the admitted prior art. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art to **combine dependent claim limitations** and to utilize any conventional coating method such as compression coating, as evidenced by the admitted prior art, to produce the functional layer, wherein the Examiner further notes that the instant claims are product-by-process claims and hence are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 227 USPQ 964,966 (Fed. Cir. 1985.)

3. Claims 1-3, 17-18, 21, 22, 24-26, 28-30, 33 and 34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 16-19, 22, 24-26, 28-30 and 33-34 of U.S. Patent No. 6,617,018, as evidenced by the admitted prior art.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art to **combine dependent claim limitations** and to utilize the instantly claimed resin support materials considering the **claimed resins are obvious species of transparent resin materials** typically utilized in the art, as evidenced by the admitted prior art, for the claimed functional films. The Examiner further notes that the instant claims are product-by-process claims and hence are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 227 USPQ 964,966 (Fed. Cir. 1985.)

#### ***Response to Arguments***

4. Applicant's arguments filed 10/2/06 have been fully considered but they are not persuasive. The Applicant argues that the Examiner's position of obviousness is unsupported and hence merely a personal conclusion since the Examiner has failed to provide any supporting evidence. However, the Examiner notes that with regards to the rejection over U.S. Patent No. 6,605,341, all of the limitations of the instant claims are found within the claims of the related patent, including a polypropylene, polyethylene, or acrylic support (Claim 11); a layer of conductive fine inorganic particles having the claimed particle size and formed from the claimed oxides (Claim 3, 8) with a transparent resin (Claim 7) and wherein the functional film is a transparent conductive film or other functional film as claimed (Claim 13). Hence, the Examiner

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maintains her position that it would have been obvious to one having ordinary skill in the art at the time of the invention to combine dependent claim limitations presented in USPN 6,605,341. With regards to the process limitations presented in the instant claims, the Examiner takes the position that these product-by-process claims do not provide any material differences between the claimed final product and the final product of USPN 6,605,341. With respect to the rejection over USPN 6,617,018, the Examiner notes that the claims of the related patent include all of the limitations of the instant claims with the exception of specifying the type of resin support as instantly claimed, e.g. PET, polycarbonate, acrylic, etc. However, the Examiner took the position that these resins are obvious resin materials utilized in the art, particularly with respect to a transparent support as utilized in many of the functional film types recited in Claim 2 of the patent. The Examiner's position is supported by the admitted prior art disclosed by the Applicant, particularly with respect to the use of PET as a support material. The Examiner is willing to provide numerous other references to support her position that these resin materials would have been obvious to one having ordinary skill in the art at the time of the invention. Hence, the Examiner maintains her position that it would have been obvious to one having ordinary skill in the art at the time of the invention to combine dependent claim limitations presented in USPN 6,617,018, utilizing the claimed resin materials as the support.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

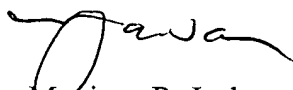
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Monique R. Jackson  
Primary Examiner  
Technology Center 1700  
December 11, 2006